

### **REMARKS**

These remarks and the above amendments are responsive to the final Office action dated December 12, 2002. Prior to the entry of this amendment, claims 1-6 and 18-33 were pending. Specifically, claims 18-25 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 1-6, 26-28 and 31 stand rejected under 35 U.S.C. § 102(b) and claims 1, 4-6, 18-26, 29-30 and 32-33 stand rejected under 35 U.S.C. § 103(a). Claims 7-17 were cancelled without prejudice in applicant's amendment filed October 22, 2002. In response to the final Office action, applicant has filed a request for continued examination. By this amendment, claims 1, 26-28, and 30, are amended, claim 29 is cancelled without prejudice, and new claim 34 is added. Applicant respectfully requests grant of this Request for Continued Examination and consideration of this amendment.

#### **Request for Continued Examination**

Applicant submitted a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This request complies with the requirements of 37 C.F.R. § 1.114(a). In particular:

- (i) Prosecution in the application is closed, since the last Office action was a final Office action under 37 C.F.R. § 1.113.
- (ii) The Request is accompanied by a submission, specifically, the amendment and the response herein.
- (iii) This Request is accompanied by the fee set forth at 37 C.F.R. § 1.17(e).

Accordingly, applicant respectfully requests grant of this Request for Continued Examination.

### **Detailed Remarks**

Claims 18-25 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that the structural features encompassed by “shaped to resemble feet” cannot be determined. Applicant has reviewed the claims and respectfully disagrees with the Examiner.

35 U.S.C. § 112, second paragraph, requires that the “claims particularly point out and distinctly claim the subject matter which applicant regards as his invention” such that such that “one skilled in the art would understand the bounds of the claim when read in light of the specification.” Miles Lab., Inc. v. Shandon Inc., 997 F.2d 870, 875 (Fed. Cir. 1993). The fact that the claim language may not be precise does not automatically render a claim indefinite under 35 U.S.C. § 112. Seattle Box Co. v. Industrial Crating & Packing Inc., 731 F.2d 818 (Fed. Cir. 1984). The acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification. MPEP § 2173.05(b).

Applicant believes that the claim language is as precise as possible and that one skilled in the art would understand the bounds of the claim. In this regard, one skilled in the art would understand what is intended by the language “shaped to resemble feet.” For example, Webster’s Third New International Dictionary (1993) defines “foot” (plural feet) as “the terminal part of the vertebrae leg upon which an individual stands consisting in most bipeds (as man) and many quadrupeds (as the cat) of all the structures (as heel, arches, and digits) below the ankle joint or in digitigrade animals (as the horse or sheep) of the terminal parts of one or more digits often encased in a horny hoof.” (pp. 884-885

def. 1). Similarly, “shaped” is defined as “having or fashioned to a particular form” (pp. 2087, def. 1a). Thus, in light of the above and in light of the specification and drawings, one skilled in the art would likely understand the phrase “shaped to resemble feet.”

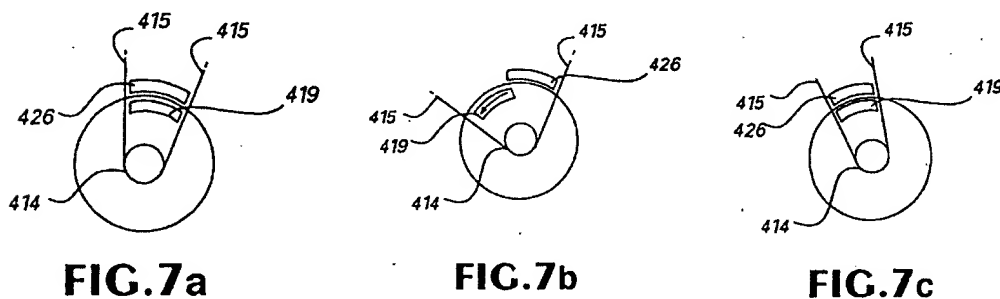
Because each of the above terms has a commonly-understood meaning, and is used in the claims in a manner consistent with that commonly-understood meaning, Appellant believes that the claims, read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention. 35 U.S.C. § 112, second paragraph, does not require anything more. Miles Lab. v. Shandon, Inc., 997 F.2d 870, 875 (Fed. Cir. 1993).

Claims 1-6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,032,548 to Del Castillo, et al. Claim 1 recites a head position assembly having a contact surface and a position monitoring structure. Claim 1 further recites that the position monitoring structure is “attached to the head and independent of the head position assembly.” The position monitoring structure is also “configured to monitor the plurality of predetermined head positions, wherein the positioning monitoring structure rotates with the head, such that the contact surface of the head position assembly triggers the position monitoring structure when the head is in the first head position.” Del Castillo does not disclose a position monitoring structure that is “attached to the head and independent of the head position assembly.”

Furthermore, Del Castillo teaches away from a positioning monitoring structure configured to monitor a plurality of head positions where the position monitoring structure “rotates with the head, such that the contact surface of the head position assembly triggers the position monitoring structure when the head is in the first head

position” as recited in applicant’s claim 1. Specifically, as stated by Del Castillo “It is important to note that because of the self-aligning feature of the clutch, it is sufficient to monitor the position of the partial output gear 406 as opposed to monitoring the position of the appendage 424.” (col. 16, lines 29-33). In other words, in Del Castillo, “the position of the appendage 424 is not monitored, ...” (col. 15, lines 15-16). Thus, Del Castillo does not teach, suggest or disclose a position monitoring structure as recited in applicant’s claim 1. Each of the dependent claims 2-6 further defines the invention of claim 1 and depends from claim 1. Each of these dependent claims should at least be allowable for the reasons described above in relation to claim 1.

Although claim 3 should be allowable based on dependence from an allowable independent claim 1, applicant notes that claim 3 recites a “a biasing structure interposed between the lower wafer and upper wafer wherein the biasing structure is adapted to bias the head back to the operational position after being physically turned by the external force.” Del Castillo does not disclose any structure that “biases the head back to the operational position.” Specifically, Del Castillo discloses in Figs. 7a-7c shown below:



Del Castillo discusses Figs. 7a-7c as follows:

When there is no obstruction, the extensions 415 of the torsion spring 414 (flexible link) hold tabs 419 and 426 together in a relative alignment, as shown in Fig. 7a. However, if an obstruction exists, the tabs 419 (driver) and 426 (follower) separate as shown in Fig. 7B. As a result, energy is stored in the torsion spring 414 until the obstruction is removed. When the obstruction is removed, the

torsion spring 414 releases the stored energy, thereby causing the tabs 419 (driver) and 426 (follower) to realign themselves as shown in Fig. 7c. (col 14, line 61- col. 15 line 4)

Thus, as shown above, Del Castillo does not bias the head back to the original operational position as recited in claim 3. Thus, the rejection to claim 3 should be withdrawn.

Claims 26-28 and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,820,233 to Weiner. Amended claim 26 recites “a first communications port operatively coupled to an upper torso portion of the doll and adapted to removably receive external components” and “a second communications port operatively coupled to a lower torso portion of the doll and adapted to removably receive external components.” Weiner does not disclose multiple communication ports on a doll, much less a first communication port on the upper torso portion of the doll and a second communication port on the lower torso portion of the doll. Therefore, applicant respectfully requests the withdrawal of the rejection of claim 26. Claims 27, 28 and 31 depend from claim 26 and should at least be allowable for the reasons described above in relation to claim 26.

Claims 1 and 4-6 also were rejected under 35 U.S.C. § 103(a) as being obvious over Leyden. As discussed above, amended claim 1 requires a “head position assembly having a contact surface” and “a position monitoring structure attached to the head” where “the positioning monitoring structure rotates with the head.” Leyden does not disclose, teach or suggest, a position monitoring structure attached to the head where the position monitoring structure rotates with the head. In Leyden, thrust rod 28 is linked to linkages 34 or 35 to affect eye and jaw movements. Neither, the thrust rod, nor the limit switches 39 and 39a, rotate with either moving part. There is no teaching or disclosure

within Leyden of a “ position monitoring structure attached to the head” where “the positioning monitoring structure rotates with the head.” Therefore, applicant respectfully requests reconsideration of the rejection of claim 1. Each of the dependent claims 4-6 further depends from claim 1 and should at least be allowable for the reasons described above in relation to claim 1.

Claims 18-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Del Castillo. Independent claim 18 recites an animated doll having a base, “a body mounted on the base having a size that is not in proportion to the base.” The head “having a size that is not in proportion to the body size.” Although the Examiner admits that Del Castillo “fails to teach the specific shape of an animated doll as required by claim 18,” the Examiner contends that it is nonetheless obvious to provide an interactive doll with the specific features of claim 18.

Obviousness requires a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The prior art reference (or combined references) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination must be found in the prior art and not based on applicant’s disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

Applicant respectfully traverses the rejection of claims 18-25 based on Del Castillo in light of the statement by the Examiner that “it would have been obvious to provide an interactive doll with all the specific features as required by claim 18 for the purpose of interest to the user since such shapes and size for a base and a body are well known in the art of dolls and/or figures.” The only reference indicated by the Examiner,

Del Castillo, does not teach, disclose or suggest a “base shaped to resemble feet configured to disguise a power source, a body mounted on the base having a size that is not in proportion to the base, and a motor driven head rotatably mounted on the body configured to disguise a motor assembly which is operatively connected to the power source and the head” where the head has “a size that is not in proportion to the body size.” Nor does the Del Castillo reference, teach, disclose or suggest that such a specific configuration for disguising a power source and a motor assembly in a doll is common knowledge in the art.

It should be noted that it is not appropriate to rely solely on common knowledge in the art without evidentiary support in the record. Thus, applicant respectfully traverses the rejection and requests that the Examiner provide the appropriate documentary evidence. Applicant is forced to make this demand because failure to make the demand may prevent applicant from later raising this issue. Chevenard, 139 F.2d 711, 713 (CCPA 1943).

Claims 29-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Weiner in view of Lebensfeld. Claim 29 has been cancelled without prejudice. As to claim 30, and as discussed above, Weiner does not disclose a doll having multiple communication ports on a doll, much less a first communication port on the upper torso portion of the doll and a second communication port on the lower torso portion of the doll as required by claim 26 from which claim 30 depends. Moreover, Lebensfeld does not disclose, teach or suggest a doll with multiple communication ports. Moreover, neither Weiner, nor Lebensfeld disclose, teach or suggest removable clothing that “includes a


contact region adapted to operatively engage the communication port.” Therefore, applicant respectfully requests the withdrawal of the rejection of claim 30.

Claims 26 and 32-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Leyden in view of Weiner. Amended claim 26 recites an interactive doll having “a first communications port operatively coupled to an upper torso portion of the doll” and “a second communications port operatively coupled to a lower torso portion of the doll.” As stated by the Examiner, “Weiner fails to teach a communication port in a torso of a doll” (paragraph 1 on page 6 of Paper No. 7). Leyden does not disclose, teach or suggest any communication ports on a doll, and thus, the combination of Leyden and Weiner fail to disclose, teach or suggest all of the recited elements in claim 26. Claims 32 and 33 depend from claim 26 and should at least be allowable for the reasons described above in relation to claim 26.

The above amendments and remarks are believed to fully address the Examiner’s rejections, and to place the entire application in condition for allowance. A prompt indication of the same is respectfully requested. The Examiner is encouraged to telephone the undersigned if any issues remain that may be resolved by a telephonic interview.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 11, 2003.

  
Sheila D. Szyplinski

Date of Signature: June 11, 2003

Respectfully submitted,

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